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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,595	07/25/2003	James R. Rivenbark	63288-592	9766

7590 04/19/2007  
McDermott, Will & Emery  
600 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER
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TAWFIK, SAMEH

ART UNIT	PAPER NUMBER
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3721

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/626,595

Applicant(s)

RIVENBARK ET AL.

Examiner

Sameh H. Tawfik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31-51 is/are pending in the application.
- 4a) Of the above claim(s) 36-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-35 and 41-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 07252003.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I (claims 31-35 and 41-51) in the reply filed on 02/28/2007 is acknowledged. The traversal is on the ground(s) that group II is not patentably distinct from group I since the identical method steps are recited in each of independent claims 31 and 36. This is not found persuasive because as been distinguished on the previous paper of the restriction requirements group II is referring to computer programming, while group I referring to a method for controlling an inserting apparatus, which is clear that both groups are different.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim\*\*\* rejected under 35 U.S.C. 102(e) as being anticipated by Auerbach (U.S. Patent No. 5,924,265).

Auerbach discloses a method for controlling an inserting apparatus over a range of master cycle speeds, the method comprising the steps of: (a) monitoring a master cycle speed at which an inserting apparatus operates over a plurality of master cycles; (b) determining when a new

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master cycle has begun; (c) at least once during every master cycle of operation of the inserting apparatus, performing a first calculation to determine a first cyclical position of the new master cycle at which an actuated device should begin to be activated, wherein the calculation is based on the master cycle speed measured for the new master cycle, a predetermined time duration required for the actuated device to become fully active, and a predetermined cyclical position of the new master cycle at which the actuated device should be fully active; and (d) at least once during every master cycle of operation of the inserting apparatus, causing the actuated device to begin to be activated when the new master cycle reaches or exceeds the calculated first cyclical position; see for example (Figs. 1, 2, 4, and 5; via control system 14 is controlling different stations on an inserting apparatus, which it is inherent such controlling system calculate cycles to control different operations via different stations). Note that by the end of each cycle, which by the end of each operation a new cycle begun to work on the following piece.

Regarding claims 32, 47, and 48: comprising the steps of (a) at least once during every master cycle of operation of the inserting apparatus, performing a second calculation to determine a second cyclical position of the new master cycle at which an actuated device should begin to be deactivated, wherein the calculation is based on the master cycle speed measured for the new master cycle, a predetermined time duration required for the actuated device to become inactive, (via by the end of each cycle, which by the end of each operation a new cycle begun to work on the following work piece); and a predetermined cyclical position of the new master cycle at which the actuated device should be fully inactive; and (b) at least once during every master cycle of operation of the inserting apparatus, causing the actuated device to become

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inactive when the new master cycle reaches or exceeds the calculated second cyclical position (note that each station gets activated and/or de-activated via control system 14).

Regarding claims 33, 42, and 49: wherein the step of causing the actuated device to begin to be activated includes energizing an envelope opening device (Figs. 4 and 5).

Regarding claims 34, 43 and 50: wherein the step of causing the actuated device to begin to be activated includes energizing an envelope registration device (Figs. 1, 4, and 5).

Regarding claims 35, 44, and 51: wherein the step of causing the actuated device to begin to be activated includes energizing a mail piece take-away device (Figs. 1, 4, and 5).

Regarding claim 41: further comprising the steps of (e) feeding an insert along a feed path at an insert feed rate in timed relation with the activation of the actuated device; (f) feeding an envelope along the feed path at an envelope feed rate in timed relation with the activation of the actuated device, wherein the insert feed rate is greater than the envelope feed rate; and (g) causing the insert to be inserted into the envelope in timed relation with the activation of the actuated device, wherein activation of the actuated device assists in an inserting process performed by the inserting apparatus, see for example (Figs. 1, 2, 4, and 5).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sameh H. Tawfik whose telephone number is 571-272-4470. The examiner can normally be reached on Tuesday - Friday from 9:00 AM to 7:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sameh H. Tawfik  
Primary Examiner  
Art Unit 3721

A handwritten signature in black ink, appearing to read 'Sameh', followed by a long horizontal line that curves slightly upwards at the end.

ST.